

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed June 19, 2006. At the time of the Final Office Action, Claims 1-9, 14, 16 and 20-26 were pending in this Application. Claims 1-9, 14, 16 and 20-26 were rejected. Claims 1m 20 and 23 have been amended to further define various features of Applicants' invention. Claims 10-13, 15 and 17-19 were previously cancelled due to an election/restriction requirement. Claims 27 and 28 have been added. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 1-6 and 14 stand rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,387,086 issued to Jean-Marie Mathias et al. ("Mathias"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

Claims 20 and 21 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by Mathias. Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that the cited art as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

The Examiner asserts that Mathias discloses a device able to support a receptacle in the standby position if it were tilted or horizontal. Applicants have amended all independent claims to recite that the claimed invention supports the receptacle in the standby position "without external assistance." Applicants believe this language excludes the use of external assistance such as a horizontal surface or rack as would be required to hold the Mathias device in a tilted or horizontal position. Applicants assert that embodiments in which the

associating device alone is sufficient to support the receptacle in the standby position are described in at least Figures 2-4.

Further, Applicants have amended the claims to recite the association device including a guide. Such a guide is disclosed at least as reference numeral 13 in the specification and figures. The claims additionally recite a first set of projections to support the receptacle in the transfer position. Such projections are disclosed at least as reference numeral 27. The claims now additionally recite a second set of projections operable to support the receptacle in the standby position. These projections allow the lack of external assistance when the receptacle is in the standby position. Such projections are disclosed at least as reference numeral 28 in the specification and figures.

Matthias discloses only projections 98 and 100 for guiding a vial over a piercing member. Col. 7, lines 22-24. These projections are not for supporting the vial.

Matthias does not disclose the support of the receptacle in the standby position without external assistance or the provision of a first or second set of projections as now claimed. Applicants request withdrawal of all rejections under 35 U.S.C. §102.

Rejections under 35 U.S.C. §103

Claims 7-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Mathias in view of U.S. Patent No. 5,364,360 issued to Antonio G. Flumene et al. ("Flumene"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

Claim 22 was rejected under 35 U.S.C. §103(a) as being unpatentable over Mathias in view of Flumene. Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

Claim 23 was rejected under 35 U.S.C. §103(a) as being unpatentable over Mathias in view of U.S. Patent No. 5,125,920 issued to Noboru Ishida ("Ishida"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

Claim 26 was rejected under 35 U.S.C. §103(a) as being unpatentable over Mathias in view of Ishida and further in view of Flumene. Applicants respectfully traverse and submit

the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

As noted above, the projections in Matthias are only disclosed as useful for guiding a vial over a piercing member. Accordingly, Matthias provides only one set of projections because a single set is sufficient for this purpose. Matthias does not disclose a second set of projections able to support a receptacle in a standby position. Accordingly, Matthias does not teach or suggest the claimed invention.

The Examiner relies on Flumene as disclosing two sets of projections to position a receptacle. However, Flumene is directed to a needle with a protective cap. Projections 12 and 13, are not operable to support a receptacle. Rather “[n]ear the opening 9, inside the cap 2, a continuous or broken annular projection 12 is foreseen, which forms a ledge suitable for preventing the needle from emerging from the opening 9.” Flumene, Col. 4, lines 13-16. “The base 4 of the needle 1 is positioned so that it is locked between the upper annular projection 12 and the lower projections 13.” Flumene Col. 4, lines 41-43. “After an injection has been made ... the cap 2 is slid downwards in order to cover the needle 1, until base 4 of the needle positions itself in the seating 14, after which the cap 2 is rotated in the opposite direction from the previous one, so as to bring the base 4 to engage with the half-moon projections 13, and therefore to prevent the possibility of the needle sliding out of its own accord.” Flumene, Col. 4, lines 56-64.

As these cited passages make clear, the projections in Flumene are used to position a needle. Specifically, projection 12 prevents the needle from emerging from an opening and

projection 13 prevents it from sliding out of a protective area after use. These functions are logical within the context of Flumene. Flumene is directed to a needle with a protective cap and projections 12 and 13 are designed to keep the needle within the protective cap.

Flumene therefore utterly fails to teach or suggest projections for positioning a receptacle. Instead it teaches projections for positioning a needle.

Further, the goal of Flumene is to keep the needle within a protective housing permanently. In contrast, Matthias specifically contemplates removal of its blood sampling vials from its receptacle. Matthias, Col. 6, lines 52-65, particularly lines 63-65. Accordingly, there is also no motivation to combine the disclosure of Matthias with that of Flumene.

The Examiner relies upon Ishida as disclosing identification tags. Identification tags have nothing to do with projections. Accordingly, the Examiner has pointed to nothing in Ishida that remedies the failure of Matthias to disclose the currently claimed invention.

Applicants request withdrawal of all rejections of the claims under 35 U.S.C. §103.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe a fee under 37 C.F.R. 1.17(a)(1) is due in connection with this response. This fee is enclosed.

Applicants additionally file an RCE with requisite fees with the current response.

Applicants believe there are no additional fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 02-0383 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2580.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicants



Michelle M. LeCointe
Reg. No. 46,861

Date: 6/29/06

SEND CORRESPONDENCE TO:

BAKER BOTTS L.L.P.

CUSTOMER NO. **23640**

512.322.2580

512.322.8383 (fax)